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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,572	12/03/2003	Patrick L. Roetzer	14634	9894

7590 11/15/2005

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EXAMINER	
WILSON, JOHN J	

ART UNIT	PAPER NUMBER
3732	

DATE MAILED: 11/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/729,572	ROETZER ET AL.	
	Examiner	Art Unit	
	John J. Wilson	3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 December 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-27* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *03 December 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 5, "said endless surface" lacks proper antecedent basis within the claim. In claim 12, line 16, "further said" is unclear as to whether it is further away from or further towards. For this Office Action, it is assumed to be further towards as shown in the drawings.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4, 6, 12, 13, 16 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Brooks (2453696). Brooks shows a shaft 15, smooth tip 35, Fig. 10, and means 33 for removing material. The shown tip is inherently capable of generating heat and is inherently capable of removing a composite compound. All of the claimed structure being shown, the intended use with a composite compound is given no patentable weight. As to claim 12, Brooks sows a shoulder between 33 and 35 as shown in Fig. 10.

Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Tuck (2807264). Tuck shows a shaft 10b, smooth rounded tip 13b and means for removing material 12b. The shown tip is inherently capable of generating heat and is inherently capable of removing a

composite compound. All of the claimed structure being shown, the intended use with a composite compound is given no patentable weight. As to claim 3, Fig. 1 shows a concave surface. As to claims 4 and 5, see concave surface and sharp tip at 13c.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 7-11, 17, 18, 23, 24, 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brooks (2453696). Brooks shows the structure as described above and further shows a rake angle in the drawings. The specific rake angle used is an obvious matter of choice in a known parameter to obtain a desired cutting to one of ordinary skill in the art. As to claim 8, see abrasive coating at 12 and 12a. To use this abrasive coating to abrade dentine is an obvious matter of choice in the intended use of a known structure to the skilled artisan. As to claims 10 and 27, the use of diamond for an abrasive is well known in the art and is an obvious matter of choice in the type of abrasive used to one of ordinary skill in the art. As to claims 17 and 23, Brooks shows an abrading surface at 12. To include a knurled surface is an obvious matter of choice in known abrading structures to one of ordinary skill in the art. As to claim 26, Brooks shows embodiments in Figs. 1, 2 and 9 that include a roughening 17, 17c on the tip. It would be obvious to include a roughening on the tip of the embodiment of Fig. 10 of Brooks in view of the

other shown embodiments to the skilled artisan in order to obtain the desired removal of material.

Claims 14 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brooks (2453696) in view of Reynaud (3832779). Brooks shows the structure as described above, however, does not show a tip having a frusto-conical shape. Reynaud shows a tip 3 having a frusto-conical shape. It would be obvious to one of ordinary skill in the art to modify Brooks to include a tip shape as shown by Reynaud in order to better guide the drill in use.

Claims 15 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brooks (2453696) in view of McSpadden (5104316). Brooks shows the structure as described above, however, does not show a tip having a cylindrical shape. McSpadden shows a tip 26 having a cylindrical shape. It would be obvious to one of ordinary skill in the art to modify Brooks to include a tip shape as shown by McSpadden in order to better guide the drill in use.

Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brooks (2453696) in view of Armstrong et al (5782636). Brooks shows the structure as described above, however, does not show a radiused edge. Armstrong shows a radiused edge 62, Fig. 2. It would be obvious to one of ordinary skill in the art to modify Brooks to include a radiused edge as shown by Armstrong in order to obtain the desired cut in use.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-11 and 22-27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,902,400. Although the conflicting claims are not identical, they are not patentably distinct from each other because to not include the relative sizes of the range of angles are obvious matters of choice in more generic claims. The shape of the tip is an obvious matter of choice in the shape of a known structure to one of ordinary skill in the art.

Claims 12-21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,902,400 in view of Brooks (2453696). The claims of the '400 patent do not include a shoulder. Brooks shows a shoulder in Fig. 10. It would be obvious to one of ordinary skill in the art to modify the claims of the '400 patent to include a shoulder as shown by Brooks in order to obtain the desired cut of the material.

Drawings

The drawings filed December 3, 2003 are objected to for hand drawn lines and poor quality copies.

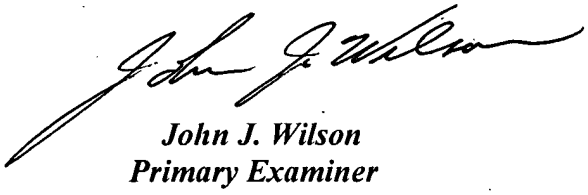
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Cohen et al (5275563) shows a drill for removing a post.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Wilson whose telephone number is 571-272-4722). The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P. Shaver, can be reached at 571-272-4720). The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John J. Wilson
Primary Examiner
Art Unit 3732

jjw
November 11, 2005